

Remarks/Arguments:

Claims 1-4, 6, 7, 11-19 are pending in the present application. Claims 1, 4 and 12 have been amended with this response. Review and reconsideration on the merits are respectfully requested in view of the following comments.

Claims 12-14 are objected to as being dependent upon a rejected base claim but indicate as being allowable if rewritten in independent form. Accordingly, claim 12 has been rewritten in independent form including the limitations of claim 11. Therefore, applicants respectfully submit that claims 12-14 are allowable and in condition for allowance.

Claim 1 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. According to the Office Action, the claim includes subject matter which was not described in the specification so as to show that the inventor had possession of the claimed invention at the time of filing the application. Furthermore, the Office contends that the specification fails to provide sufficient written support demonstrating sufficient breadth to use the broad term “a 1,2-diol.” Applicants respectfully traverse this rejection for the following reasons.

The written description requirement is satisfied if “one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Claim 1 of the present application recites “a 1,2-diol selected from the group consisting of 1,2-pentanediol, 1,2-hexanediol, 1,2-octanediol and mixtures thereof.” Accordingly claim 1 refers to specific 1,2-diols in a Markush group. These 1,2-diols were present in the claims as originally filed and explicitly described in the specification as filed. Therefore, applicants respectfully submit that claim 1 complies with the written description requirement and request that the rejection be withdrawn.

Claims 1, 3, 7, 11, 15 and 18 stand rejected as being unpatentable over JP 11322591. According to the Office Action, JP ‘591 discloses an antimicrobial composition comprising a C₄

- C₁₀ 1,2-alkanediol in combination with benzoic acid and phenoxyethanol. Furthermore, the Office concludes that it would have been obvious to determine the optimum amounts of each component in the composition. Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness with respect to these claims.

Factors to be evaluated in determining obviousness include “the scope and content of the prior art...differences between the prior art and claims at issue...and the level of ordinary skill in the pertinent art.” *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731 (2007). However, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 1741. A finding of obviousness must be based on more than “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id. quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). All claim limitations must be identified in the cited references to establish a *prima facie* case of obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006).

The cited reference, even when modified as suggested by the Office, fails to disclose each and every limitation of the pending claims. Claim 1 recites an antimicrobial composition **consisting essentially of** defined amounts of (a), (b), and optionally (c). The cited reference does not teach or suggest such a composition. One of ordinary skill in the art would have to pick and choose from the possible components set forth in JP ‘591 to include some components while excluding others to arrive at the composition set forth in claim 1 of the present application. Moreover, there is absolutely no motivation or suggestion provided in the reference to provide the individual components in the percentages set forth in the claims of the present application. According to the Office, one of ordinary skill in the art would have been motivated to determine optimum amounts to get maximum effectiveness. However, applicants respectfully submit that the purported motivation is insufficient to suggest modifying the disclosure in the cited reference

to arrive at the composition set forth in the claims of the pending application. The purported motivation fails to take into account or consider the fact that the claimed composition consists essentially of (a), (b) and optionally (c) and the fact that the percentages of these components will vary depending upon other constituents of the composition. Applicants' composition in a defined weight ratio provides a concentrated antimicrobial composition system which can deliver water insoluble biocides into aqueous personal care product systems at relatively high concentrations, thus providing more effective preservative activity for such products. Accordingly, the Office has failed to articulate "reasoning with some rational underpinning to support the legal conclusion of obviousness." Therefore, applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness for at least this reason as well and request that the rejection be withdrawn.

Claims 1-4, 6, 7, 11 and 15-19 stand rejected as being unpatentable over JP 2003286153. JP '153 discloses skin preparations using sorbic acid, benzoic acid, etc., and phenoxyethanol or phenoxyisopropanol and optionally diols. Applicants respectfully submit that the cited reference fails to render obvious the claims of the present application. The reference discloses skin preparations containing various antimicrobial components but fails to disclose or suggest an antimicrobial composition consisting of defined amounts of a 1,2-diol, phenoxyethanol and optionally a co-biocide as set forth in the claims of the pending application. The Office has simply identified a reference containing the individual components set forth in the claims of the pending application and concluded that it would be obvious to arrive at an antimicrobial composition consisting essentially of the defined amounts of the selected components set forth in the claims of the pending application. Applicants respectfully submit that the JP '153 reference fails to render the pending claims for all the same reasons as discussed above with respect to the JP '591 reference. Therefore, for at least this reason as well, applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness and request that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that all of the pending claims are in condition for allowance and favorable action on the merits is requested. In the event that the

Application. No.: 10/820,349
Docket No.: FDN-2837
AMENDMENT

Examiner wishes to discuss any aspect of this response, please contact William J. Davis at (973) 628-3529 or the undersigned at the telephone number indicated below. We hereby authorize the Commissioner under 37 C.F.R. § 1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted:

By: /John F. Kane/
John F. Kane
Reg. No. 44,815

THOMPSON HINE LLP
2000 Courthouse Plaza N.E.
10 West Second Street
Dayton, Ohio 45402-1758
Telephone: (937) 443-6816
Facsimile: (937) 443-6635

552298.1